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PATENT
Case No. **AUS920010440US1**
(9000/43)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	)	
	)	
RABINDRANATH DUTTA	)	Examiner: DASS, HARISH
	)	
Serial No.: 09/915,439	)	
	)	Group Art Unit: 3628
Filed: JULY 26, 2001	)	
	)	Conf. No.: 7368
Title: METHOD FOR PROVIDING	)	
ANONYMOUS ON-LINE	)	
TRANSACTIONS	)	

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Brief on Appeal as follows:

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1. **REAL PARTY IN INTEREST**

The real party in interest is assignee INTERNATIONAL BUSINESS MACHINES

CORPORATION, a corporation organized and existing under the laws of the State of New

York, USA and located at New Orchard Road, Armonk, New York 10504, USA

2.   RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorneys are not aware of any appeals or any

interferences which will directly affect or be directly affected by or having a bearing on the

Board's decision in the pending appeal.

3.   **STATUS OF CLAIMS**

Claims 1 -25 are currently pending in the application and stand finally rejected under

35 U.S.C. §103(a) as unpatentable over Hambrecht in view of certain images identified as

"eBay." All claims are on appeal. See, the Appendix.

4.   **<u>STATUS OF AMENDMENTS</u>**

No amendments have been made, and therefore no amendments have been entered in the application.

5.   **SUMMARY OF CLAIMED SUBJECT MATTER**

Independent Claim 1:

Independent claim 1 recites a method for performing an anonymous online transaction. The method includes receiving 220 a request for an enhanced certificate from a requestor at a certificate authority server 40 and determining 235 whether the requestor qualifies for the enhanced certificate 70. The method further includes issuing 240 the requestor an enhanced certificate 70 from the certificate authority server 40 if the requestor qualifies, receiving 380 an offer from a supplier with a supplier enhanced certificate 70 at an aggregate exchange server 50, and receiving a bid from a purchaser with a purchaser enhanced certificate 70 at the aggregate exchange server 50. Further, the method includes determining 390 whether the bid matches the offer, sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending 400 the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer, and receiving 410 agreement of the matched supplier and purchaser at the exchange server 50 to execute the transaction. See, for example, FIGS. 1, 2, 8 and 9 as well as pages 5-12 of the specification.

Independent Claim 11:

Independent claim 11 recites a computer usable medium including a program for performing an anonymous online transaction. The medium includes computer readable code for receiving 220 a request for an enhanced certificate from a requestor at a certificate

authority server 40 and computer readable code for determining 235 whether the requestor

qualifies for the enhanced certificate 70. The medium further includes computer readable

code for issuing 240 the requestor an enhanced certificate 70 from the certificate authority

server 40 if the requestor qualifies, computer readable code for receiving 380 an offer from a

supplier with a supplier enhanced certificate 70 at an aggregate exchange server 50, and

computer readable code for receiving a bid from a purchaser with a purchaser enhanced

certificate 70 at the aggregate exchange server 50. Further, the medium includes computer

readable code for determining 390 whether the bid matches the offer, computer readable code

for sending the supplier the purchaser enhanced certificate from the aggregate exchange

server, and computer readable code for sending 400 the purchaser the supplier enhanced

certificate from the exchange server, if the bid matches the offer, and computer readable code

for receiving 410 agreement of the matched supplier and purchaser at the exchange server 50

to execute the transaction. See, for example, FIGS. 1, 2, 8 and 9 as well as pages 5-12 of the

specification.

Independent Claim 21:

Independent claim 21 recites a system for performing an anonymous online

transaction. The medium includes means for receiving 220 a request for an enhanced

certificate from a requestor at a certificate authority server 40 and means for determining 235

whether the requestor qualifies for the enhanced certificate 70. The medium further includes

means for issuing 240 the requestor an enhanced certificate 70 from the certificate authority

server 40 if the requestor qualifies, means for receiving 380 an offer from a supplier with a

supplier enhanced certificate 70 at an aggregate exchange server 50, and means for receiving

a bid from a purchaser with a purchaser enhanced certificate 70 at the aggregate exchange

server 50. Further, the medium includes means for determining 390 whether the bid matches

the offer, means for sending the supplier the purchaser enhanced certificate from the

aggregate exchange server, and means for sending 400 the purchaser the supplier enhanced

certificate from the exchange server, if the bid matches the offer, and means for receiving

410 agreement of the matched supplier and purchaser at the exchange server 50 to execute

the transaction. See, for example, FIGS. 1, 2, 8 and 9 as well as pages 5-12 of the

specification.

6.   **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-25 were rejected as unpatentable under 35 U.S.C. §103(a) as unpatentable

over Hambrecht, 6,629,082 in view of "eBay".

7.   **ARGUMENTS**

The rejection of claims 1-25 as unpatentable under 35 U.S.C §103(a) over Hambrecht in view of eBay is traversed. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The combination of Hambrecht and "eBay" fails to teach or suggest each and every element of the claims, and therefore the §103(a) rejection fails. Specifically, the references alone or in combination fail to teach or suggest "sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer" as claimed in claims 1, 11 and 21. The Examiner correctly does not rely on Hambrecht for any such teaching, and instead relies on the eBay images for support for such a teaching.

Hambrecht teaches an auction system and method for pricing and allocation during capital formation, while the eBay auction website provides consumer-to-consumer auctions. EBay specifically, and unequivocally, teaches that the "Feedback Ratings empower users to make an informed choice about someone they plan to do business with. So before *bidding on an item*, check out the Feedback Profile of the seller." See, page 6 of the document "Information on eBay, Inc." captioned with a handwritten "3" as produced by the Examiner (emphasis added). EBay further teaches (on the same page) the desirability of "Get to

Know Your Trading Partner" and the desirability of establishing "a reputation through the use of our Feedback Forum" allowing users to "build up their reputation in the eBay community and earn the trust and respect of others in the community."

Such a teaching _unequivocally teaches away_ from the claimed "sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer". Such a claim element can only be satisfied if the purchaser and supplier _do not know each other's identity until a bid is matched with an offer_. If the purchaser and supplier do not know the other's identity, the taught feedback system is of questionable utility. Indeed, the Examiner fails to offer any arguments, much less evidence, as to how knowledge of a trading partner's identity can fit in an anonymous system. Additionally, "eBay" specifically teaches the desirability of checking out a seller's Feedback Profile _before bidding on the item_, as noted above. Appellant further notes that the claim preamble specifically requires that the transaction be anonymous – the opposite of the eBay teachings. Obviously, if a Feedback Profile is checked prior to bidding, the identity of the seller must be known and therefore it is a logical impossibility to only provide identity if the bid matches the offer if the identity is exchanged prior to making the bid! The Examiner's logic twists the "chicken and egg" question by apparently arguing that the omelet comes before the egg.

Hambrecht does not cure this defect of "eBay." In fact, Hambrecht further teaches away from the instant claims. While Hambrecht does not teach that the entity being formed with the capital formation needs to know the identity of the investors, Hambrecht clearly

teaches that the inventors need to know the identity of the entity being formed. For example,

see the abstract:

> Techniques are provided for an auction system that is used
> for pricing and allocating equity securities. Information
> about an offering to accept bids for equity shares is provided
> to qualified potential purchasers and non-qualified potential
> purchasers. Bids from potential purchasers for equity shares

Additionally, even if at least one of the references did teach each and every claim

element (which Appellant does not concede), the combination of Hambrecht and "eBay" still

fails, as there is no motivation to combine these references. Neither Hambrecht nor "eBay"

denounce as less than perfect an auction system in which at least one party knows the identity

of the other party prior to bidding. Furthermore, neither reference teaches the desirability of

an anonymous auction.

Indeed, the mere fact that either reference can be modified as suggested by the

Examiner does not render the resultant modification obvious unless the prior art also suggests

the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.

Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious

composition by drawing air into the cementitious composition by driving the output pump at

a capacity greater than the feed rate. The prior art reference taught that the feed means can

be run at a variable speed, however the court found that this does not require that the output

pump be run at the claimed speed so that air is drawn into the mixing chamber and is

entrained in the ingredients during operation. Although a prior art device "may be capable of

being modified to run the way the apparatus is claimed, there must be a suggestion or

motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re

Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device

which is conformable to a ground surface of varying slope not suggested by combination of

prior art references).

In addition, the arguments cited by the Examiner in the final rejection actually

support the Appellants' position. The Examiner argues that it "is obvious that the trading

partner should know the ability of the trading partner at least he/she can pay/ship, whether

the parties know each other or not." Such an argument ignores the benefits of the

'anonymous' method and system claimed. While the Examiner is correct that the parties

should know each other's identity to pay/ship, such information is not exchanged using the

method, computer usable medium and system claimed herein, un*til after the bid and offer

have been matched*. The Examiner has ignored the entire point of the claims and has failed

to consider the terms used. Likewise, the fact that international trading parties often use

trusted intermediaries such as banks and use of letters of credit and the like is not relevant to

the claims requiring anonymous bidders and sellers until after the bid has matched the offer.

Claims 2-10, 12-20 and 22-25 depend directly or indirectly from one of claims 1, 11,

or 21, and are therefore patentable over the references for at least the same reasons.

Withdrawal of the rejections to claims 1-25 is requested.

CONCLUSION

The Appellants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **December 22, 2006**   Respectfully submitted,
                                                 RABINDRANATH DUTTA, *et al.*

                                                 /FRANK C. NICHOLAS/
CARDINAL LAW GROUP   Frank C. Nicholas
Suite 2000   Registration No. 33,983
1603 Orrington Avenue   Attorney for Appellants
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113

9. CLAIMS APPENDIX

1.   A method for performing an anonymous online transaction comprising:

        receiving a request for an enhanced certificate from a requestor at a certificate authority server;

        determining whether the requestor qualifies for the enhanced certificate;

        issuing the requestor an enhanced certificate from the certificate authority server if the requestor qualifies;

        receiving an offer from a supplier with a supplier enhanced certificate at an aggregate exchange server;

        receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server;

        determining whether the bid matches the offer;

        sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer; and

        receiving agreement of the matched supplier and purchaser at the exchange server to execute the transaction.

2.   The method of claim 1 wherein the certificate authority server comprises the aggregate exchange server.

3.   The method of claim 1 wherein the enhanced certificate comprises financial data, credit rating data, financial routing data and identification data.

4.   The method of claim 1 wherein issuing the requestor an enhanced certificate comprises implementing at least one security feature.

5.   The method of claim 4 wherein the security feature is selected from a group consisting of a user password, a public key cryptograph, a digital signature, and an XML based security standard.

6.   The method of claim 1 further comprising:

providing a hyperlink to the aggregated exchange server wherein the hyperlink comprises the certificate request.

7.   The method of claim 6 wherein the hyperlink is provided on a web site for access by the requestor.

8.   The method of claim 1 further comprising:

verifying a portion of requestor financial information with an outside server.

9.   The method of claim 8 wherein verifying the portion of requestor financial information comprises determining eligibility for an enhanced certificate.

10.   The method of claim 8 further comprising:

updating requestor financial information.

11.   A computer usable medium including a program for performing an anonymous online transaction comprising:

computer readable code for receiving a request for an enhanced certificate from a requestor at a certificate authority server;

computer readable code for determining whether the requestor qualifies for the enhanced certificate;

computer readable code for issuing the requestor an enhanced certificate from the certificate authority server if the requestor qualifies;

computer readable code for receiving an offer from a supplier with a supplier enhanced certificate at an aggregate exchange server;

computer readable code for receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server;

computer readable code for determining whether the bid matches the offer;

computer readable code for sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer; and

computer readable code for receiving agreement of the matched supplier and purchaser at the exchange server to execute the transaction.

12.   The computer usable medium of claim 11 wherein the certificate authority server comprises the aggregate exchange server.

13.   The computer usable medium of claim 11 wherein the enhanced certificate comprises financial data, credit rating data, financial routing data and identification data.

14.   The computer usable medium of claim 11 wherein issuing the requestor an enhanced certificate comprises implementing at least one security feature.

15.   The computer usable medium of claim 14 wherein the security feature is selected from a group consisting of a user password, a public key cryptograph, a digital signature, and an XML based security standard.

16.   The computer usable medium of claim 11 further comprising:

computer readable code for providing a hyperlink to the aggregated exchange server wherein the hyperlink comprises the certificate request.

17.   The computer usable medium of claim 16 wherein the hyperlink is provided on a web site for access by the requestor.

18.   The computer usable medium of claim 11 further comprising:

computer readable code for verifying a portion of requestor financial information with an outside server.

19.   The computer usable medium of claim 18 wherein verifying the portion of requestor financial information comprises determining eligibility for an enhanced certificate.

20.   The computer usable medium of claim 18 further comprising:

computer readable code for updating requestor financial information.

21.   A system for performing an anonymous online transaction comprising:

means for receiving a request for an enhanced certificate from a requestor at a certificate authority server;

means for determining whether the requestor qualifies for the enhanced certificate;

means for issuing the requestor an enhanced certificate from the certificate authority server if the requestor qualifies;

means for receiving an offer from a supplier with a supplier enhanced certificate at an aggregate exchange server;

means for receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server;

means for determining whether the bid matches the offer;

means for sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and means for sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer; and

means for receiving agreement of the matched supplier and purchaser at the exchange server to execute the transaction.

22.   The system of claim 21 further comprising:

means for implementing at least one security feature.

23.   The system of claim 21 further comprising:

means for providing a hyperlink to the aggregated exchange server.

24.   The system of claim 21 further comprising:

       means for verifying a portion of requestor financial information with an
outside server.

25.   The system of claim 24 further comprising:

       means for updating requestor financial information.

10   **EVIDENCE APPENDIX**

Appellants entered no evidence pursuant to §1.130, 1.131 or 1.132, and the Examiner

entered no evidence that was relied upon by Appellants.

11.   **RELATED PROCEEDINGS APPENDIX**

There are no copies of related decisions or proceedings.